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EXAMINER

PHAN, TRI H

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 09/26/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,201

Applicant(s)

MA ET AL.

Examiner

Tri H. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 11, 15 and 19 is objected to because of the following informalities:

In claim 11, line 10, the phrase "... a defined protocol." should be -- said defined protocol -- for clarity.

Similar problem exists in claim 15, line 11; claim 19, line 12.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 10, 14 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claim 4, lines 4-5, the phrase "a variable response" is vague and indefinite because it is unclear whether the limitation(s) are part of the claimed invention, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Similar problem exists in claim 10, line 5; claim 14, line 4; claim 18, line 5.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-2, 5-7, 12 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by **Glitho et al.** (U.S.6,614,784).

- In regard to claim 1, **Glitho** discloses in Figs. 4-6, 7A-B; Abstract and in the respective portions of the specification about the method and system for providing supplementary services (“*supplemental services messaging*”; For example see Col. 2, Lines 24-48; Fig. 2; Col. 6, Line 52 through Col. 7, Line 2) in the integrated telecommunications network (“*network connection*”) having packet-switched network or H.323-based network 102 (“*voice frame network*”) and circuit-switched network with the gateway, gatekeepers (For example see Col. 2, Lines 12-23), intelligent terminals (“*intelligent peripheral*”) and service control point (“*voice frame network gatekeeper*”) as disclosed in Fig. 4; Col. 7, Line 56 through Col. 8, Line 30; for providing advanced services and provisioning supplementary services through service request (“*conveying a request*”) and response (“*conveying a response*”) as disclosed in Col. 3, Line 37 through Col. 4, Line 42; in the H.323/H.450 framework (“*defined protocols*”; For example see Col. 2, Lines 35-

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48) of Intelligent Network architecture; wherein the call Re-routing Request and call Re-routing Answer ("*call-transfer request/response sequence*") are used for the call diversion service at the first entity, i.e. gatekeeper, (For example see Figs. 6, 7A-B; Col. 9, Line 24 through Col. 10, Line 43).

- Regarding claim 2, **Glitho** further discloses about the provisioning Supplementary Services using H.450.X messages encapsulated in H.225 signaling of the H.323-based network ("*protocol and command structure comply with International H.323 and H.225 standards*"; For example see Col. 2, Lines 35-62).

- In regard to claim 5, **Glitho** discloses in Figs. 4-6, 7A-B; Abstract and in the respective portions of the specification about the method and system in the integrated telecommunications network having packet-switched network or H.323-based network 102 ("*voice frame network*") and circuit-switched network with the gateway, gatekeepers (For example see Col. 2, Lines 12-23), intelligent terminals ("*intelligent peripheral*") and service control point ("*voice frame network gatekeeper*") as disclosed in Fig. 4; Col. 7, Line 56 through Col. 8, Line 30; for providing advanced services and provisioning supplementary services through service request/response as disclosed in Col. 3, Line 37 through Col. 4, Line 42; in the H.323/H.450 framework; wherein the service control point, e.g. "*gatekeeper*" or endpoint (For example see Col. 8, Lines 7-21), with distributed functional plane to support call diversion ("*invocation mechanism, performance mechanism*"; For example see Col. 8, Line 56 through Col. 9, Line 7; Col. 6, Line 55 through Col. 7, Line 2) through all life cycle phases and provide the advanced

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and provisioning supplementary services such as call hold, call waiting, message indication, toll free and credit card calling, or multimedia applications such as video-on-demand, etc. (*“defined task”*; For example see Col. 2, Lines 35-48; Col. 10, Line 60 through Col. 11, Line 5) based on H.450.X messages encapsulated in H.225 signaling (*“in-band signaling”*; For example see Col. 2, Lines 57-62) of H.450/H.323 service architecture (*“comply with H.323 and H.450 standards”*).

- Regarding claims 6-7, 12 and 16, **Glitho** further discloses about the provisioning Supplementary Services using H.450.X messages in the H.323 network; wherein the served entities or service control point, e.g. *“supplemental services provider”* can trigger service requests to a service node or intelligent terminal, i.e. *“intelligent peripheral”*, (For example see details in Figs. 6, 7A-B) through the use of call Re-routing Request and Answer (*“call-transfer request/response sequence”*) to re-route the call (For example see Col. 5, Lines 52-65).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 8-9, 11, 13, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Glitho et al.** (U.S.6,614,784) in view of **Sassin et al.** (U.S.6,449,260).

- In regard to claims 3, 8, 13 and 17, **Glitho** discloses all the subject matter of the claimed invention as discussed in part 5 rejection above, including the provisioning Supplementary Services for call diversion such as call hold, call park-call pickup, call waiting and message indication, toll free and credit card calling, selective call restriction, click to fax, double phone/free phone, split charging, or multimedia applications such as tele-medicine, tele-education, video-on-demand, etc., (For example see Col. 2, Lines 35-48; Col. 10, Line 53 through Col. 11, Line 5); but fails to specifically disclose about “*play-recorded-audio and play-recorded-audio-and-await-digital-input sequences*”. However, it is obvious that playing background music (“*play-recorded-audio*”) in call hold, call waiting and message indication or in toll free and credit card calling, selective call restriction, video-on-demand while waiting for user’s input (“*play-recorded-audio-and-await-digital-input sequences*”) can implement in the command of Value-Added Services and provisioning Supplementary Services in the H.450/H.323-based service architecture and is known in the art.

For example, **Sassin** discloses about the music/video server providing background music and announcements or video data to calls placed on hold in the H.323 network (For example see Figs. 1-5; in Col. 3, Lines 15-24; Col. 5, Lines 31-54).

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to combine the invention as taught by **Sassin**, by implement the music/video server providing background music and announcements or video data to calls placed on hold in the H.323 network in **Glitho**’s system with the motivation being to put the user at ease

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while waiting for call transfer or user's input in toll free and credit card calling, selective call restriction, or in video-on-demand.

- Regarding claim 9, **Glitho** further discloses about the provisioning Supplementary Services using H.450.X messages in the H.323 network; wherein the served entities or service control point, e.g. "*supplemental services provider*" can trigger service requests to a service node or intelligent terminal, i.e. "*intelligent peripheral*", (For example see details in Figs. 6, 7A-B) through the use of call Re-routing Request and Answer ("*call-transfer request/response sequence*") to re-route the call (For example see Col. 5, Lines 52-65).

- In regard to claims 11, 15 and 19, **Glitho** discloses all the subject matter of the claimed invention as discussed in part 5 rejection above, about the functional program (For example see Fig. 5; Col. 8, Line 56 through Col. 9, Line 23), system and method in the integrated telecommunications network having packet-switched network or H.323-based network 102 ("*voice frame network*") and circuit-switched network with the gateway, gatekeepers (For example see Col. 2, Lines 12-23), intelligent terminals ("*intelligent peripheral*") and service control point ("*voice frame network gatekeeper*") as disclosed in Fig. 4; Col. 7, Line 56 through Col. 8, Line 30; for providing advanced services and provisioning supplementary services using H.450.X messages in the H.323 network; wherein the served entities or service control point, e.g. "*supplemental services provider*" can trigger service requests to a service entity or intelligent terminal, i.e. "*intelligent peripheral*", (For example see details in Figs. 6, 7A-B) through the use of call Re-routing Request and Answer ("*call-transfer request/response sequence*") to re-route



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the call through service request (“*conveying a request*”) and response (“*conveying a response*”) as disclosed in Col. 3, Line 37 through Col. 4, Line 42; Col. 5, Lines 52-65; in the H.323/H.450 framework (“*defined protocols*”; For example see Col. 2, Lines 35-48); but fails to specifically disclose the use of “*IVR*” as the service entity or intelligent terminal. However, such implementation is known in the art.

For example, **Sassin** discloses in Figs. 1-5 and in the respective portions of the specification about the use of H.323 compatible Integrated Voice Response Unit “*IVR*” or music/video server as the service entity as specified in Col. 5, Line 3-20; for allowing customer to communicate information to the ACD server as the H.323 end point through the gatekeeper by using the third party application ‘API’ in ACD server (For example see Figs. 2-3; Col. 4, Line 52 through Col. 6, Line 23; Fig. 5; Col. 7, Lines 20-46)

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to combine the invention as taught by **Sassin**, by implement the “*TVR*” or music/video server providing background music and announcements or video data to calls placed on hold in the H.323 network in **Glitho**’s system with the motivation being to put the user at ease while waiting for call transfer or user’s input in toll free and credit card calling, selective call restriction, or in video-on-demand.

#### ***Allowable Subject Matter***

8. Claims 4, 10, 14 and 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Petrunka et al.** (U.S.6,122,364) and **Cave et al.** (U.S.6,404,746) are all cited to show devices and methods for improving packet network communication architectures, which are considered pertinent to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (703) 305-7444. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W. Olms can be reached on (703) 305-4703.

**Any response to this action should be mailed to:**

**Commissioner of Patents and Trademarks**

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 305-3900.



Tri H. Phan  
September 9, 2003



DANG TON  
PRIMARY EXAMINER